

REMARKS

Applicant respectfully requests reconsideration of the instant application on the basis of newly amended Claim 1. Claim 1 is the sole remaining main claim and the remaining claims are directly or indirectly dependent upon that independent claim.

The Examiner has rejected the claims as being unpatentable over U.S. Patent No. 6,150,650 by Bowen *et al.* (*Bowen*). It is believed that Claims 1 to 11 are clearly distinguishable over the *Bowen* reference for the reasons that will be set forth.

Support for the amendment of Claim 1 is found in the specification, paragraph numbers [0012] and [0013] and others.

The *Bowen* patent centers around an MX-10160 image tube with a flex tail that goes into an AN/PVS-14 monocular system. The *Bowen* patent talks about electronics for tube and power supply interfacing to Night Vision Goggle ("NVG") system which resides both inside and outside of the image tube package. See *Bowen*, column 3, lines 36 through 44 and lines 60 through 63.

As conceded by *Bowen*, "one skilled in the art" would know that the electronic package for MX-10160 is "stuffed to the gills" with electronics (there is no extra volume for enhancement electronics). This is the novelty to the *Bowen* patent as some electronics is mounted outside the MX-11769 tube package coupled to the *Bowen* claims. See *Bowen*, column 3, lines 60 through 63.

35 U.S.C. § 102(b) Grounds for Rejection

The Examiner has principally rejected the claims as being anticipated by *Bowen*. It is believed that Claims 1 to 11 are clearly distinguishable over the *Bowen* reference for the reasons that will be set forth.

Independent Claim 1 recites the following elements, the most pertinent to this discussion being presented in bold type for the convenience of the Examiner:

1. (currently Amended) An adaptive electrical circuit unit for use in a night viewer system of the type that includes an image intensifier tube and a compatible power source electrically connected to the image intensifier tube, the invention comprising:

a voltage gain detection circuit unit operably connected to the image intensifier tube for detecting multiple selected types of image intensifier tubes as replacements for an original image intensifier tube and producing an output gain signal appropriate to the detected image intensifier tube for controlling the gain of the detected image intensifier tube; and,

said voltage gain detection circuit unit mounted within a main body.

Since such circuit being mounted within a main body of the Applicant's invention as claimed are not disclosed or suggested by *Bowen*, Applicant suggests that the claimed structure of the present invention is neither identical to nor disclosed by the *Bowen* device. Therefore, *Bowen* cannot anticipate the present claimed invention.

Even if the *Bowen* patent incidentally showed a similar arrangement of parts, if that arrangement is neither claimed nor designed to perform the function of the present invention, that patent can not act as an anticipation.

35 U.S.C. § 103 Grounds for Rejection

The Examiner rejected Claims 2, 5-8 and 10 under 35 U.S.C. § 103(a) as being unpatentable over the Patent by *Bowen*. Applicant respectfully traverses these rejections for the reasons discussed below.

Applicants' invention is directed toward solving the disadvantage that night vision devices heretofore were designed to accept a single type of image intensifier tube and were not adaptable to accept multiple types of image intensifier tubes. Prior to the present invention the user of a night vision device had to replace the installed image intensifier tube with a tube of the same type, which may not always be readily available. See *Bowen* which addressed the only issue of interchanging one tube with another tube of the same type. See *Bowen*, column 2, lines 23 through 43 and other places that talks about the differences in calibration between two tubes that need to be specifically calibrated for the system since the tube itself "does not offer variable gain." *Bowen*, column 2, lines 17.

Since night vision devices are often used by members of the military during operations and maintenance supplies may be limited, there is a need for the night vision device to be adapted to use another tube type that might be available.

Even if one were to insert (and there is no suggestion of doing so in *Bowen*) another image intensifier tube type in *Bowen*'s night vision device, the night vision device would not have the independent capability to determine the type of replacement tube and establish the

proper electronic signals necessary for operation of that specific tube type different than the tube type being replaced.

It is improper to use hindsight having read the Applicant's disclosure to "pick and choose" among isolated prior art references to disparage the claimed invention. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Even where an invention is, as a whole, fully disclosed by a combination of prior art elements, such elements cannot be combined to defeat a patent as obvious unless the art teaches or suggests the desirability of making the combination. ASC Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 U.S.P.Q. 929 (Fed. Cir. 1984). Thus, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, U.S.P.Q.2d 1780 (Fed. Cir. 1992). Finally, it is the invention as a whole that is important. Focusing on the obviousness of substitutions and differences, instead of on the invention as a whole, is a legally improper way to simplify the often difficult determination of obviousness. Gillette Co. v. S. C Johnson & Son, Inc., 919 F.2d 720, 16 U.S.P.Q. 1923 (Fed. Cir. 1990).

Independent Claim 1, as amended, is quoted above with the most pertinent elements to this discussion being presented in bold type for the convenience of the Examiner.

Applicant respectfully submits that *Bowen* does not disclose, teach, or suggest the circuit being mounted within a main body of the Applicant's invention as recited by amended Claim 1.

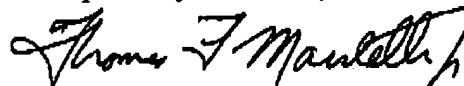
Dependent Claims 2-11 that depend from independent Claim 1 are also not made obvious by *Bowen* because they include the limitations of Claim 1 and add additional elements that further distinguish the art. Therefore, Applicant respectfully requests that Claims 1-11 be allowed.

Conclusion

Applicant has now made an earnest attempt to place this case in condition for allowance. In light of the amendments and remarks set forth above, Applicant respectfully requests reconsideration and allowance of Claims 1-11.

If there are matters which can be discussed by telephone to further the prosecution of this Application, Applicant invites the Examiner to call the attorney at the number listed below at the Examiner's convenience.

Respectfully submitted,



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